

AMENDMENT AFTER FINAL
August 21, 2006

TUC920030082US1
Serial No. 10/644,209

REMARKS

Claims 1 – 20 remain in the application and stand finally rejected. Claim 13 is objected to. Claims 1, 8, 11 and 14 are amended by this proposed amendment.

Claim 13 is objected to for containing informalities, i.e., not being indicated as “original.” Responsive thereto, claim 13 is labeled “original” herein. Reconsideration and withdrawal of the objection to the claims is respectfully requested.

Claims 1, 2, 5, 6, 7, 8, 14, 18 and 19 are finally rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,088,182 to Taki et al. in view of U.S. Patent No. 5,561,530 to Kanazawa. Claims 3, 4 and 10 are finally rejected under 35 U.S.C. §103(a) over the combination of Taki et al. and Kanazawa in further view of U.S. Patent No. 6,539,459 to Tadokoro et al. Claim 9 is finally rejected under 35 U.S.C. §103(a) over the combination of Taki et al. and Kanazawa in further view of U.S. Patent No. 5,579,234 to Wiley et al. Claims 11 – 13 are finally rejected under 35 U.S.C. §103(a) over the combination of Taki et al., Kanazawa and Wiley et al. in further view of U.S. Patent No. 5,774,725 to Yadav et al. Claims 15 – 17 and 20 are finally rejected under 35 U.S.C. §103(a) over the combination of Taki et al. and Kanazawa in further view of U.S. Patent No. 6,724,096 to Fisher et al.

In responding to the applicants’ remarks in the prior amendment, the final Office action asserts that “testing the media independent of insertion into the library database,” is not recited in claim 1. While the applicants assert that this was inherent in claims 1 – 10 as filed, Claim 1 is amended by this proposed amendment to affirmatively recite that “tested said storage media are tested without being inserted into a library database for said storage array.” Lines 8 – 10. In particular, this is supported by claim 8 and claims

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14 – 19 as originally filed. Claim 8 recited that the “storage media in said physical storage volume tested in step (c) is tested without inserting logical volumes on tested said storage media into a data library.” Insertion in the data library required inclusion in the library database and inclusion in the library database indicated presence in the data library. Further, claim 14 clearly differentiated between “removable storage media and test storage media” with only the test storage media being tested in claims 14 and 16 and only the removable storage media being included in the virtual server database in claim 15 and operated on by the configuration database and the management database in claim 20. Further, inserting and removing the test storage media being tested would not result in the media being “tested transparently to each said host system” as recited by claim 20.

Be that as it may, however, in addition to amending claim 1, claim 8 is amended to depend from claim 10 and recite “inserting logical volumes into said data library comprises loading said storage media into a configuration database.” Lines 2 – 4. This is neither taught nor suggested by any reference of record. Further, claim 11 is amended to recite “wherein said tested storage media are tested without being inserted into a library database for said data library.” Line 14. Also, claim 14 is amended to further indicate that “removable storage media [is] inserted in a data library” at line 4. Neither are claims 11 or 14 as amended taught or suggested by any reference of record. No new matter is added. The amendment to claims 8, 11 and 14 is supported by the specification in general and the claims as filed. Further, no reference of record teaches or suggests testing storage media such that “tested said storage media are tested without being inserted into a library database for said storage array.” Therefore, it is believed that claims 1, 8 and 14, as amended are patentable over all references of record. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1, 8 and 14 is respectfully requested.

Furthermore, none of the other references of record adds anything to Taki et al. and Kanagawa to result in testing storage media such that “tested said storage media are

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tested without being inserted into a library database for said storage array" as recited in claim 1 with analogous recitations in claim 14, as amended. Because dependent claims include all of the differences with the cited references as the claims from which they depend, claims 2 – 7, 9, 10 and 15 – 20, which depend from amended claims 1 and 14, are believed patentable over Taki et al. and Kanagawa, alone or, further in combination with any reference of record. Entry of the amendment, reconsideration and withdrawal of the final rejection to claims 1 – 10 and 15 – 20 under 35 U.S.C. §103(a) over the combination of Taki et al. and Kanagawa alone, or further in combination with any reference of record is respectfully requested.

Regarding the rejection of claims 11 – 14 over Taki et al., Kanazawa and Wiley et al. in further view of Yadav et al., in responding to the applicants' prior comments, the final Office action relies on Kanazawa et al. to show "tested storage media are tested without being inserted into said data library." As far as the applicants can tell, the Kanazawa et al. VCR does not include anything that would remotely be considered a "data library." Certainly "library" is not found anywhere in Kanazawa et al. If there is no library, inserting or not inserting tested media in a data library cannot be taught or suggested. Therefore, very clearly, Kanazawa et al. does not show "tested storage media are tested without being inserted into said data library." Be that as it may, however, claim 11 is amended to recite "wherein said tested storage media are tested without being inserted into a library database for said data library." Line 14. This is neither shown nor suggested by any reference of record and supported by the specification as set forth hereinabove. Accordingly, the combination of Taki et al., Kanazawa, Wiley et al. and Yadav et al. does not result in the present invention as recited in claim 11, as it stands or, as amended by this proposed amendment.

Furthermore, because dependent claims include all of the differences with the cited reference as the claims from which they depend, the combination of Taki et al., Kanazawa, Wiley et al. and Yadav et al. does not result in the present invention as recited

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in claims 12 – 14, which depend from claim 11. Entry of the amendment, reconsideration and withdrawal of the final rejection to claims 11 – 14 under 35 U.S.C. §103(a) over the combination of Taki et al., Kanazawa, Wiley et al. and Yadav et al. is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance both for the amendment to the claims and for the reasons set forth above, the applicant respectfully requests that the Examiner enter the amendment, reconsider and withdraw the objection to the claims, reconsider and withdraw the final rejection of claims 1 – 20 under 35 U.S.C. §103(a) and allow the application to issue.

The applicants note that MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration. (emphasis added.)

The applicants believe that the written description of the present application is quite different than and not suggested by any reference of record and that the claims as amended reflect those differences. However, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

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Please charge any deficiencies in fees and credit any overpayment of fees to IBM
Corporation Deposit Account No. 09-0449 and advise us accordingly.

Respectfully Submitted,

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(Date)

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